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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,785	05/05/2000	SIMON A BEDDUS	36-1338	3443

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EXAMINER	
MEHRA, INDER P	

ART UNIT	PAPER NUMBER
2666	11

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/530,785	BEDDUS ET AL.	
	Examiner	Art Unit	
	Inder P Mehra	2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2004* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-12 and 17-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-12 and 17-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Response to Amendment

1. This is in response to an amendment C dated 6/4/04 which has been fully considered and made of record. Based on this amendment, claim 1 has been cancelled in amendment B dated 8/28/03, claims 13-16 were cancelled in amendment C dated 6/4/04. Claims 19-21 were added in amendment C. Claims 2-12 and 17-21 are now pending.

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Objections

3. Claims 3-18 are objected to because of the following informalities:

Claims 3-7 and 11-12 (line1), and 9 (line 1) recite the limitation "A method". There is insufficient antecedent basis for this limitation in the claim.

Claim 9 (line 1) recites the limitation "A communication network". There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation " ***the call control capability exchange protocol***" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2-3 and 8-12 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **P.Mikelaitis** (A Tutorial on ISDN customer call control, part 1, the telecommunication journal of Australia, vol. 38, No. 1, pages 75-92, XP002075878), hereinafter, Mikelaitis in view of **Christensen et al** (US Patent no. 5,561,666), hereinafter, Christensen, further in view of **Mori, Naoki** (EP 0606079), hereinafter, Mori..

For claims 2-3, 8-10 and 17-21, Mikelatis discloses a method of operating a communications systems including terminals (claim 9), refer to paragraph 4.3 and figs. 5.1 and 5.2, comprising:

- exchanging (see figs. 5.3 and 5.8, paragraphs 5.4 and 5.5 respectively) between communication terminals ("customers") call control capability data ("signaling dialogue", refer to paragraph 4), which call control capability data identifies for each respective terminal al least a selected one or more of a plurality of different call control protocols (message sequences, refer to paragraph 4 and different network addresses, **as recited by claims 2-3, 8-10 and 17-21** (individual characteristics), refer to paragraph 4;
- setting up a call between the said communications terminals using call control protocols or network addresses identified in call control capability data, **as**

recited by claims 2-3, 8-10 and 17-21, (paragraph 4, capability data, setup control, refer to paragraph 4);

- wherein the exchanging of the call control capability data is carried out ***prior to initiating call set up, as recited by claims 2-3, 8-10 and, 17-21,*** (once the network is able to proceed with the call (i.e all necessary information is available to the exchange) a signaling association over CCSS No. 7 is established between the calling and called exchanges , paragraph 5.4, once the D-channel signaling dialogue results in network wide connection for user traffic---a customer can not only ***transfer information ---but can also transfer user information,*** paragraph 5.5).
- wherein a first one of the commuting terminals initiates the exchange of call control capability------***returns an acknowledgement to request -----includes call control capability data for ---terminals, as recited by claim 3,*** (messages of both groups, connect acknowledge, set up acknowledge), refer to paragraphs 5.4 and 5.5.

Mikelaitis discloses, "wherein the exchanging of the call control capability data is carried out ***prior to initiating call set up, as recited by claims 2, 17 and 18, and 18, as explained above;***

However, Christensen discloses expressly, "wherein the exchanging of the call control capability data is carried out ***prior to initiating call set up*** (a station---network ***determines the mode in which it communicates with a concentrator port by establishing a Registration***

routing----. The station and concentrator port exchange frames which disclosethe capabilities of concentrator port, refer to abstract, and co. 2 lines 17-22.

Further, Mori, Naoki (EP 0606079) discloses explicitly, "**the call control capability data**" (user terminals transmit a signaling packet) **which call control capability data identifies for each respective terminal at least a selected one of a plurality of different call control protocols and different network addresses** (containing in it a source network address (a protocol identifier plus a source network address) and (a destination network address (the protocol and destination user address), refer to abstract and col. 1 lines 15-20 and col. 1 line 56 through col. 2 line 6, col. 2 lines 18-22.

Mori, Naoki (EP 0606079) discloses explicitly, "wherein the exchanging of the call control capability data is carried out prior to initiating call set-up", refer to col. 1 lines 22-23 and col. 3 lines 30-34.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the capability of , "exchanging of the call control capability data is carried out ***prior to initiating call set up"*** . The capability can be implemented by the user network interface (UNI) to initiate and determine the mode and carry the capability data ***prior to initiating call set up, as taught by Mori***. The suggestion/motivation to do so would have been to match the traffic types and quality of service requirements.

For claims 11 and 12, Mikelaitis discloses, "wherein the call control capability data for the second terminal identifies one of the following: (i) a plurality of---------protocols, (ii) a plurality of different network addresses, and (iii) at least on call control protocol and at least one

network addresses, (ine information they carry specify the individual characteristics---can include amongst others, the following: destination address and originating addressrefer to paragraph 4.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **P.Mikelaitis** and **Christensen,** as applied to claim 3 above, and further in view of **Katsube** (US Patent no. 4,984,264).

For claims 4 and 5, Mikelaitis and Christensen disclose a method comprising the steps described in paragraph 4 of this office action.

Mikelaitis and Christensen disclose all the subject matter of the claimed invention with the exception of :

- monitoring continuously at a communications terminal a communication port and carrying out the exchange of call control capability data whenever a request is received at the said port, as recited by claim 4;
- monitoring of the communications port continues after a call has been set up, as recited by claim 5;

Katsube discloses monitoring continuously at a communications terminal a communication port and carrying out the exchange of call control capability data whenever a request is received at the said port, refer to col. 7 lines 54-63 ; and monitoring of the communications port continues after a call has been set up, refer to col. 7 lines 43-50;

A person of ordinary skill in the art would have been motivated to employ Katsube's cell flow monitoring system into Mikelaitis's "Tutorial on ISDN customer call control" in order to

monitor and control the execution of exchange of data across two terminals. The suggestion/ motivation to do so would have been to transmit successfully information from terminals having various characteristics.

7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **P. Mikelaitis** and **Christensen**, as applied to claim 3 above, and further in view of **Markgraf et al** (US Patent no. 6,181,691), hereinafter, Markgraf.

For claims 6 and 7, Mikelaitis and Christensen disclose a method comprising the steps described in paragraph 4 of this office action.

Mikelaitis and Christensen disclose all the subject matter of the claimed invention with the exception of :

- communicating as part of the said call control capability data a pointer to a source of further data identifying capabilities not provided for directly in the call control capabilities exchange protocol, as recited in claim 6;
- the pointer is a uniform resource locator (URL), as recited by claim 7;

Markgraf discloses communicating as part of the said call control capability data a pointer to a source of further data identifying capabilities not provided for directly in the call control capabilities exchange protocol; and the pointer is a uniform resource locator (URL); (URL specifies high level communication function like "set up connection" and "participate in connection", refer to abstract and col. 3 lines 10-15 and col. 4 lines 25-30.

A person of ordinary skill in the art would have been motivated to employ Markgraf's telephone system into Mikelaitis's "Tutorial on ISDN customer call control" in order to provide

"URL" pointer. The suggestion/ motivation to do so would have been to transmit successfully information from terminals having various characteristics.

Response to Arguments

8. Applicant's arguments filed 6/4/04 have been fully considered but they are not persuasive.

9. Applicant argues, "In order to establish a prima facie case of obviousness, all of claimed limitations must be taught or suggested by the prior art.

a. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

b. In this case, Mikelaitis and Christensen fails to teach or suggest all of the claimed limitations, for example, the combination fails to teach or suggest

Applicant argues, "Mikelaitis fails to disclose, "wherein the exchanging of the call control capability data is carried out prior to initiating a call set-up".

In response, it is stated that Mikelaitis discloses, "once the network is able to proceed

with the call (i.e all necessary information is available to the exchange) a signaling association over CCSS No. 7 is established between the calling and called exchanges , paragraph 5.4, once the D-channel signaling dialogue results in network wide connection for user traffic----a customer can not only ***transfer information ---but can also transfer user information,*** paragraph 5.5).

Further, Christensen discloses expressly, "wherein the exchanging of the call control capability data is carried out ***prior to initiating call set up*** (a station---network ***determines the mode in which it communicates with a concentrator port by establishing a Registration routing----. The station and concentrator port exchange frames which disclose the capabilities of concentrator port, refer to abstract, and col. 2 lines 17-22.***

Applicant disagrees and argues, "there is no communication of information from the destination terminal to the originating terminal (or vice versa) in Mikelaitis until after the call has been established".

In response, it is stated that Mikelaitis discloses establishes an ISDN call set up, refer to paragraph 5.4, prior to fig. 5.3b. Once the signaling messages are complete, "call proceeding" message is sent in response.

Further, Mori, Naoki (EP 0606079) discloses explicitly, "**the call control capability data**" (user terminals transmit a signaling packet) **which call control capability data identifies for each respective terminal at least a selected one of a plurality of different call control protocols and different network addresses** (containing in it a source network address (a protocol identifier plus a source network address) and (a destination network address (the

protocol and destination user address), refer to abstract and col. 1 lines 15-20 and col. 1 line 56 through col. 2 line 6, col. 2 lines 18-22.

Mori, Naoki (EP 0606079) discloses explicitly, "wherein the exchanging of the call control capability data is carried out prior to initiating call set-up", refer to col. 1 lines 22-23 and col. 3 lines 30-34.

In light of above explanation, arguments provided by Applicant are not persuasive.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Inder P Mehra whose telephone number is 703-305-1985. The examiner can normally be reached on 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 703-308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Inder Mehra
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Examiner
Art Unit 2666

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SUPERVISORY PATENT EXAMINER